

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Applicants note that December 7, 2008, falls on a Sunday. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 1-4 have been amended. Also, claims 5-8 have been added. Thus, claims 1-8 are pending in the present application.

No new matter has been added by way of these amendments as such amendments are clarifying in nature. By deleting/amending these terms in order to clarify the claimed invention (e.g., “characterized in that” to “wherein”), Applicants are in no way conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

New claims 5-6 are embodiments deleted from claim 4. New claims 7-8 have support in the specification at least at page 5, lines 10-16. No new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Recent Information Disclosure Statement

Applicants note that an Information Disclosure Statement was filed on August 21, 2008, which was filed after the issuance of the latest Office Action. Consideration of the reference cited therein and a copy of the initialed SB/08 are respectfully requested.

Issues under 35 U.S.C. § 102(b) and § 103(a)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by **Misaki '996** (U.S. Patent No. 4,765,996) (see pages 2-4 of the Office Action).

Also, claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over **Misaki '996** (see pages 4-5 of the Office Action).

Applicants respectfully traverse and reconsideration is based on the following remarks.

A key difference between the present invention and Misaki '996 is that the enriched rice of the present invention is prepared using an emulsifying agent-coated iron salt composition. Misaki '996 is prepared using iron alone. In other words, the cited Misaki '996 reference fails to disclose or suggest the enriched rice or barley having an emulsifying agent-coated iron salt composition as instantly claimed. In this regard, as the M.P.E.P. directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP § 2143.03.

Still, in the Office Action at page 3, lines 4-5, the Examiner asserts that the process of the present invention and the process of Misaki '996 do not give a different end product, and thus the product as claimed cannot be distinguished from that of Misaki '996. Applicants respectfully disagree. In order to clarify this issue, Applicants herein enclose a Declaration pursuant to 37

C.F.R. § 1.132 by co-inventor Noboru SAKAGUCHI. In the Rule 132 Declaration, four different examples were prepared (i.e., “Enriched Rice 1-4”).

As described at pages 2-3, “**Enriched Rice 1**” was prepared in accordance with Example 5 of Misaki ‘996. As a comparison to Enriched Rice 1, “**Enriched Rice 2**” was also prepared in accordance with Example 5 of Misaki ‘996, except the aqueous suspension containing ferric pyrophosphate was replaced with an emulsifying agent-coated iron salt composition as described in Example 1 of Applicants’ specification. Enriched Rice 2 represents the present invention.

Also, “**Enriched Rice 3**” was prepared in the same way as Example 8 of Applicants’ specification, but carried out using the vitamins and minerals according to Example 5 of Misaki ‘996 (using the aqueous suspension containing ferric pyrophosphate). As a comparison to Enriched Rice 3, “**Enriched Rice 4**” was prepared in the same way as Enriched Rice 3 except the aqueous suspension containing ferric pyrophosphate of Misaki ‘996 was replaced with an emulsifying agent-coated iron salt composition as described in Example 1 of Applicants’ specification. In other words, Enriched Rice 4 represents the present invention.

With these four examples, three different tests were conducted which measured: (1) residual ratio (%) of vitamins and minerals in the product, which is the finally prepared enriched rice (see Table I); (2) the percentage (%) of loss after washing the enriched rice (see Table II); and (3) residual ratio (%) after a one-month storage of the product (see Table III).

Table I on page 4 of the Rule 132 Declaration clearly shows that Enriched Rice products **2** and **4** (representing the present invention that utilizes an emulsifying agent-coated iron salt composition) have higher content of vitamins and iron, versus the comparative examples (Enriched Rice products **1** and **3**) (representing Misaki ‘996 that uses an aqueous suspension

containing ferric pyrophosphate). For instance, Enriched Rice 2 has a significantly higher residual ratio of 69.0% versus the 29.8% of Enriched Rice 1.

Similarly, **Table II** shows unexpected results for the present invention. **Table II** contains data for percent loss of vitamins and minerals after washing the rice. Both Enriched Rice 2 and 4 (utilizing the emulsifying agent-coated iron salt composition) have lower loss percentages of vitamins and minerals than the comparative examples of Enriched Rice 1 and 3. Less vitamins and minerals are lost upon washing the rice with the present invention.

Likewise, **Table III** shows unexpected results for the present invention. **Table III** contains data for percent loss of vitamins and minerals after being stored for one month. Both Enriched Rice 2 and 4 have higher residual ratios (%) of vitamins and minerals than the comparative examples of Enriched Rice 1 and 3. The present invention has achieved excellent storage stability.

Thus, the Misaki '996 product and process is different from that of the present invention. As seen from the Rule 132 Declaration, the Misaki '996 embodiment leads to higher losses of vitamins and minerals, whether such losses are measured when the product was made, after washing, and after storage for one month. And again, Misaki '996 is prepared using iron alone.

Accordingly, these rejections of claims 1-4 have been overcome. Specifically, regarding the rejection of claims 1-3 under § 102(b), anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1990) (citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Because of the lack of disclosure of all features as instantly claimed (e.g., a different end

product is being claimed), the rejection for anticipation in view of Misaki '996 has been overcome.

Regarding the rejection under § 103(a), wherein claim 4 depends on claim 1 (and claims 5 and 6 are embodiments of the subject matter deleted from amended claim 4), this rejection has also been overcome. Applicants note that M.P.E.P. § 2143 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors of: determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims that are at issue; resolving the level of ordinary skill in the pertinent art; and evaluating any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Second, the Examiner has to provide some rationale for determining obviousness, wherein M.P.E.P. § 2143 set forth some rationales that were set established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Here, the Examiner has not appropriately resolved the *Graham* factors, including ascertaining the differences between the prior art and the claims that are at issue, and the rationale in combining the cited references is improper. For one, a different end product is being claimed as explained. Thus, the *Graham* factor of ascertaining the differences between the prior art and the claims that are at issue resides in Applicants' favor.

Further, the *Graham* factor of evidence of secondary considerations lies in Applicants' favor. Regarding the described emulsifying agent-coated iron salt composition, Applicants

respectfully refer the Examiner to the unexpected results shown in the attached Rule 132 Declaration.

Furthermore, Applicants respectfully refer the Examiner to the unexpected results shown in the present specification. When looking at the Inventive Products versus the Comparative Products M and N, enriched rice that is prepared using an emulsifying agent-coated iron salt obtained in Comparative Examples 1 and 2, the losses of vitamins are prevented (Table 1 at page 24) and the residual ratios after storage increased (Table 2 at page 25). The excellent effects are obtained because a reaction generated by a direct contact of iron and vitamins is controlled in the present invention by using an emulsifying agent-coated iron salt composition. Applicants note that when evidence of unexpected results is in the present specification, it is improper to not consider such evidence of patentability for the present invention. *See In re Soni*, 54 F.3d 746, 34 U.S.P.Q.2d 1684 (Fed. Cir. 1995) (error not to consider evidence in the specification); M.P.E.P. § 2144.08(II)(B).

Based on the comments above and the attached Rule 132 Declaration, the cited Misaki '996 reference fails to disclose all claimed features and the advantages of the present invention. Reconsideration and withdrawal of both rejections are respectfully requested.

Conclusion

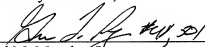
A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: December 8, 2008

Respectfully submitted,

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Attachment: Declaration under 37 C.F.R. § 1.132